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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,415	02/05/2002	Mattia De Dominicis	108910-00051	4132

7590 08/23/2006

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EXAMINER

TUROCZY, DAVID P

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/062,415

Applicant(s)

DE DOMINICIS ET AL.

Examiner

David Turocy

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/14/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9 and 11-20 is/are allowed.
- 6) ☒ Claim(s) 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/16/2006 has been entered.

Response to Amendment

2. Applicant's amendments, filed 5/16/2006, have been fully considered and reviewed by the examiner. The examiner notes the amendments to claims 1 and 10, wherein claims 1-20 remain pending in the instant application.

Election/Restrictions

3. Claim 1 is generic and allowable. Accordingly, the restriction requirement as to the encompassed species is hereby withdrawn and claims 3-4, 6-7, 11, 18, and 19, directed to the non-elected species no longer withdrawn from consideration since all of the claims to this species depend from or otherwise include each of the limitations of an allowed generic claim.

Response to Arguments

4. Applicant's arguments filed 5/16/2006 have been fully considered but they are not persuasive.

The applicant has argued against the Visca reference stating the reference teaches of applying the perfluoropolymer to a metallic surface to confer water/oil repellency and such a characteristic is not analogous to anticorrosive properties. While the examiner agrees Visca is directed to providing a metallic surface with water and/or oil repellency, the examiner maintains the position that both the prior art of Visca and the present claims require the same process steps. The prior art and the present claims, reflected by claim 1, teach all the same process steps and thus the results obtained by applicants process must necessarily be the same as those obtained by the prior art. Therefore by applying a bifunctional polyfluoropolyether phosphoric ester compound to a metal substrate, it must necessarily result in conferring anticorrosive properties. Either 1) the applicant and the prior art have different definitions for applying to a metal substrate a bifunctional polyfluoropolyether phosphoric ester compound, or 2) the applicant is using other process steps or parameters that are not shown in the claims.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1762

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 10 is rejected under 35 U.S.C. 102(b) as being anticipated by EP 1006168 by Visca et al, hereafter Visca.

Claim 10: Visca teaches applying a bifunctional polyfluoropolyether phosphoric ester compound to the surface of various substrates, including metal (Abstract, Paragraph 0007). Visca discloses using a compound, see formula III and specifically example 3, that corresponds to the elected species (B) (Paragraph 0011, 0043). Visca teaches of providing metal substrate with water repellency characteristics, which results in conferring a certain amount of anti-corrosive properties (Abstract).

Allowable Subject Matter

7. Claims 1-9, 11-20 are allowed.

8. The following is a statement of reasons for the indication of allowable subject matter: None of the prior art cited or reviewed by the examiner, alone or in combination, reasonably suggested pretreating a metal substrate with the claimed perfluoropolyether and the calcium carbonate adhering to the substrate is easily removed with running water.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Turocy whose telephone number is (571) 272-2940. The examiner can normally be reached on Monday-Friday 8:30-6:00, No 2nd Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

David Turocy
AU 1762



**TIMOTHY MEKS
SUPERVISORY PATENT EXAMINER**